

REMARKS

In a Final Office Action mailed on February 20, 2004, objections were made to the title, the abstract, and the drawings; claims 8-14, 21-26 and 29-30 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite; claims 1-3, 6, 15-17, 19 and 20 were rejected under 35 U.S.C. § 102(b) as being anticipated by Huang; claims 1-30 were rejected under 35 U.S.C. § 102(e) as being anticipated by Taruishi; claims 1-3 and 5-30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over alleged Applicant's Admitted Prior Art ("APA") in view of Huang; and claim 4 was rejected under 35 U.S.C. § 103(a) as being unpatentable the APA in view of Huang and in further view of Yanagawa.

The title has been amended to overcome the objection to the title. Furthermore, the Abstract has been amended to overcome the objection to the Abstract. Regarding the objections to the drawings, the drawings have been changed to overcome the objections to the drawings. More specifically, Applicant submits with this Reply annotated and replacement sheets of drawings for the Examiner's approval. The Examiner states that "PCI" should be written out as "Peripheral Component Interconnect," in the paragraph that begins on line 15 on page 10. However, directs the Examiner's attention to lines 16 and 17 of this paragraph which clearly define "PCI" as "Peripheral Component Interconnect (PCI)." Thus, withdrawal of this objection is requested. Newly added claims 31-42 are patentable over the cited art. The §§ 112, 102 and 103 rejections are addressed below.

§ 112 Rejections:

The Examiner maintains the § 112 rejections of claims 8-14, 21-26, 29 and 30. In essence, the Examiner is maintaining the rejections because the claims do not specify "how" the amplifiers are enabled "in response to a predetermined operation occurring." Once again, Applicant submits to the Examiner that it is not the function of the claims to explain "how" the amplifiers are enabled. As acknowledged by the Examiner, the specification describes at least one embodiment in which the amplifiers are enabled at the beginning of operation. This is an

example of enabling amplifiers in response to a predetermined operation occurring. Applicants do not desire to narrow the claim scope to a specific embodiment, but rather, Applicant desires to maintain the breadth of the claim scope to cover embodiments in which the amplifiers are enabled at some other point of the operation other than the beginning. Because the Examiner has failed to show where the claims fail to satisfy the two requirements set forth in § 112, withdrawal of the § 112 rejections of claims 8-14, 21-26, 29 and 30 is requested. The Examiner states that the "metes and bounds" requirement of § 112 has not been met. However, by the Examiner's own acknowledgement, the scope of this meaning is clear, as the Examiner recognizes that one embodiment of this language is the selective enablement of amplifiers occurring at the beginning of a predetermined operation.

§§ 102 and 103 Rejections of Claims 1-29:

The Examiner maintains the §§ 102 and 103 rejections in the Final Office Action due to the interpretation of "memory bus" as being any set of lines, such as the I/O bit lines in a memory device. Although Applicant submits that the Examiner is parsing "memory" from "memory bus" to arrive an unreasonable interpretation, Applicant has amended the claims to address the Examiner's concerns. As amended, each of the independent claims state that the memory includes communication lines that indicate data signals and indicate at least one data strobe signal associated with a timing of the data signals. Thus, for at least this reason, withdrawal of the §§ 102 and 103 rejections of claims 1-29 is requested.

In the Final Office Action, the Examiner states, "the requirement as suggested by Applicants that a reference specifically refer to another reference in order to provide proper motivation and suggestion to combine the references is tantamount to requiring a 35 U.S.C. 102 reference." Final Office Action, 17. However, contrary to the Examiner's conclusion, a *prima facie* case of obviousness requires the Examiner to show where the prior art contains the alleged suggestion or motivation to for the combination and/or modification of a reference. As a § 103 rejection requires at least two references, the Applicant fails to see the Examiner's reasoning

regarding how the requirement of showing a suggestion or motivation in the art is tantamount to a § 102 rejection.

"Obviousness cannot be predicated on what is unknown." Thus, the Examiner must provide citations to a prior art reference that establishes the alleged suggestion or motivation to combine and/or modify references to derive the claimed invention; and the Examiner must show where the prior art teaches or suggests all claim limitations. *Ex parte Gambogi*, 62 USPQ2d 1209, 1212 (Bd. Pat. App. & Int. 2001); *In re Rijckaert*, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993); M.P.E.P. § 2143.

In *In re Fine* 5 USPQ2d (1596 (Fed. Cir. 1988), the Federal Circuit held that the Examiner had failed to establish a *prima facie* case of obviousness because of the Examiner's bald assertion that a substitution "would have been within the skill of the art," without offering any support for or explanation of this conclusion. *In re Fine*, 5 USPQ2d at 1599. The Federal Circuit agreed with the appellant that a *prima facie* case of obviousness had not been established and stated, "one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *Id.*, 1600. *See also, W.L. Gore & Associates, Inc v. Garlock, Inc.*, 220 USPQ 303, 312-13 (Fed. Cir. 1983) (stating, " to imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against his teacher"); *Al-Site Corp. v. VSI Int'l, Inc.*, 50 USPQ2d 1161, 1171 (Fed. Cir. 1999) (stating, " rarely, however, will the skill in the art component operate to supply missing knowledge or prior art to reach an obviousness judgment").

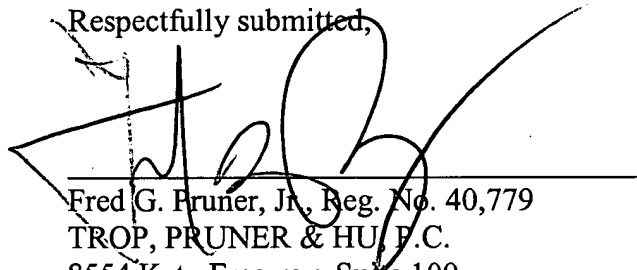
Thus, the Examiner has failed to show where the prior art teaches or suggests modifying Huang so that Huang's memory device selectively disables amplification of data that are received *from* a memory bus. The Examiner is using improper hindsight to modify Huang in view of the alleged Admitted Prior Art to derive the claimed invention. However, the Examiner must show that one skilled in the art, *without knowledge of the claimed invention*, would have modified Huang to derive the claimed invention. The Examiner has failed to make this showing; and

therefore, for at least this reason, a *prima facie* case of obviousness has not been set forth for any of the claims.

CONCLUSION

In view of the foregoing, a favorable action in the form of a Notice of Allowance is requested. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 20-1504 (ITL.0668US).

Respectfully submitted,



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